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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,788	06/28/2006	Oliver Winzenried	125542-1006	5003
32914 7590 02/18/2009 GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761				
EXAMINER				
COPPOLA, JACOB C				
ART UNIT		PAPER NUMBER		
3621				
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02/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/584,788

Applicant(s)

WINZENRIED ET AL.

Examiner

JACOB C. COPPOLA

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-42 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-28 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Remarks and Amendments filed on 26 November 2008, hereinafter "08 Remarks" and "08 Amendments."
2. Claims 11-42 are currently pending.
3. Claims 11-28 and 31-42 have been examined.
4. This Office Action is given Paper No. 20090213. This Paper No. is for reference purposes only.

Restrictions

5. Applicants' election of claims 11-28 in the 08 Remarks is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
6. Claims 29 and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-17, 21-25, and 31-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. (U.S. 2003/0074569 A1) (“Yamauchi”), in view of Murakami et al. (U.S. 2005/0144019 A1) (“Murakami”).

9. Regarding claim 21:

- a. Yamauchi discloses the following limitations:
 - i. *reading of the license parameters belonging to the licensor from memory* (see ¶0019 and ¶0030);
 - ii. *sending the read license parameters* (see ¶0030);
 - iii. *restoring the authorization code corresponding to the received license parameters* (see ¶0030);
 - iv. *returning the restored authorization code to the computer of the licensee* (see ¶0030);
 - v. *storing the restored authorization code in the data-processing device connected to the computer of the licensee in a device-specific format in the data-processing device* (see figure 2 and associated text);
 - vi. *receiving the license parameters* (see ¶0030);
 - vii. *evaluating the license parameters* (see ¶0030); and
 - viii. *deciding whether the requested authorization code should be restored and returned to the licensee* (see ¶0030).
- b. Yamauchi does not specifically disclose that the licensing parameters are read from a security file. Murakami, however, discloses a security file that contains licensing

parameters similar to the licensing parameters that Yamauchi has stored in memory (see Murakami, figure 12 and associated text; and Yamauchi, ¶0019 and ¶0030).

c. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the memory of Yamauchi the security file as taught by Murakami since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

d. Additionally, Yamauchi does not specifically disclose that the licensing parameters are sent to a licensor, where the licensor restores the authorization code.

e. Murakami, however, discloses a licensor server in communication with a customer, where the licensor server stores licensing information. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the licensor server of Murakami in place of the memory card of Yamauchi to backup the license key and to provide recovery of the license key in the event that the memory card of Yamauchi is lost, corrupted, or destroyed.

10. Regarding claim 22:

f. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

ix. *the license parameters are signed with time information for protection and are provided in the security file (see Murakami, figure 12 and associated text).*

- g. Additionally, Yamauchi/Murakami does not specifically disclose in ¶ 0030 of Yamauchi that the license parameters are provided at least partially in encrypted form in the security file. Yamauchi instead stores the information in a tamper resistant hardware structure (see figure 1 and associated text).
 - h. Yamauchi, however, does disclose storing licensing parameters in encrypted form outside of the security file (see figure 2 and associated text).
 - i. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to also encrypt the licensing parameters within the security file in order to provide additional security.
11. Regarding claim 23:
- j. Yamauchi/Murakami discloses the limitations of claim 21, as shown above. Yamauchi/Murakami, further, discloses the limitations:
 - x. *sending licensing parameters stored in the security file to the licensor* (see rejection to claim 21);
 - xi. *evaluating the licensing parameters by the licensor* (see rejection to claim 21); *and*
 - xii. *generating an authorization code corresponding to the licensing parameters* (see rejection to claim 21).
 - k. Additionally, Murakami discloses time information stored in a security file (see figure 12 and associated text)
 - l. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the

prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the time information of Murakami for the licensing parameters of Yamauchi. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

12. Regarding claim 24:

m. Yamauchi/Murakami discloses the limitations of claim 21, as shown above. Yamauchi/Murakami, further, discloses the limitations:

xiii. *characterized in that several authorization codes for licenses of several licensors are stored on the data-processing device* (see Yamauchi, ¶0026).

13. Regarding claim 25:

n. Yamauchi/Murakami discloses the limitations of claim 21, as shown above. Yamauchi/Murakami, further, discloses the limitations:

xiv. *characterized in that remote data connections are established to all licensors, in order to permit the corresponding authorization codes to be restored* (see at least Murakami, figure 1 and associated text).

14. Regarding claims 11-17, these claims are understood by the Examiner to be of substantially the same scope as claims 21-25. Accordingly, claims 11-17 are rejected in substantially the same manner as claims 21-25.

15. Regarding claims 31 and 33:

o. Yamauchi/Murakami discloses the limitations of claims 11 and 21, as shown above. Yamauchi/Murakami, further, discloses the limitations:

xv. *wherein the security file on the licensee's computer does not include the authorization code* (Murakami, fig. 12 with associated text).

16. Regarding claim 32:

p. Yamauchi/Murakami discloses the limitations of claim 11, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

i. *wherein the authorization code is storable only on the access-protected data processing device* (Yamauchi, figs. 1-2)

17. Regarding claims 34-39, these claims recite substantive elements relative to claims 21-25. Accordingly, claims 34-39 are rejected in substantially the same manner as claims 21-25.

18. Claims 18-20, 26-28, and 40-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi/Murakami, in view of Chandrasekaran et al. (U.S. 6,335,972 B1) ("Chandrasekaran").

19. Regarding claims 26 and 27:

q. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

xvi. *establishing a remote data connection between the computer of the licensee and licensor* (see Murakami, figure 1 and associated text);

(1) *sending the security file to the licensor* (see rejection to claim 21);
and

xvii. *establishing a data connection between the computer of the licensor and the licensee* (see Murakami, figure 1 and associated text).

- r. Yamauchi/Murakami does not specifically disclose *a central management computer*.
 - s. Chandrasekaran, however, does disclose an intermediary central management computer (see figure 2.1 and associated text).
 - t. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the structure of Yamauchi/Murakami the central management computer as taught by Chandrasekaran since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.
20. Regarding claim 28:
- u. Yamauchi/Murakami/Chandrasekaran discloses the limitations of claims 21 and 26, as shown above. Yamauchi/Murakami/Chandrasekaran, further, discloses the limitations:
 - xviii. *reading the serial number from the security file* (see rejection to claim 21);
and
 - xix. *sending the serial number to a management computer* (see rejection to claim 26).
 - v. Yamauchi/Murakami/Chandrasekaran does not specifically disclose the following limitations:
 - xx. *storing the serial number in a block list at the management computer*.

- w. However, Yamauchi, does disclose storing the serial number ("apparatus specific ID") in a block list at the memory card. The Examiner has already shown that the features of the memory card as disclosed by Yamauchi may be incorporated into the licenser server of Matsushima, as shown in the rejection to claim 21. Likewise, one of ordinary skill in the art, at the time the invention was made would recognize the licenser server of Matsushima and the management computer of Chandrasekaran, also a server (see figure 2.1 and associated text), as interchangeable parts. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.
21. Regarding claims 18-20, these claims are understood by the Examiner to be of substantially the same scope as claims 26-28. Accordingly, claims 18-20 are rejected in substantially the same manner as claims 26-28.
22. Regarding claims 40-42, these claims recite substantive elements relative to claims 26-28. Accordingly, claims 40-42 are rejected in substantially the same manner as claims 26-28.
23. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

24. Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

- x. *license* “1a. Official or legal permission to do or own a specified thing.” (The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000).

Response to 08 Remarks

25. Regarding claims 11 and 21, Applicants argue “First, the apparatus-specific ID, which the examiner is apparently contending is a license parameter, does not appear to be a license parameter” (p. 11 of the 08 Remarks). The Examiner respectfully disagrees. In ¶ 0019 Yamauchi discloses “[t]he apparatus-specific ID is a number uniquely assigned to each one of one or more audio content reproduction apparatus, and thus an identity of the audio content reproduction apparatus can be confirmed by reference to the apparatus-specific ID” [emphasis added]. Here Yamauchi discloses that each device has its own unique ID. Then, in ¶ 0030, Yamauchi discloses a method where a comparison is made between a received apparatus-specific ID and a stored apparatus-specific ID. If the comparison is successful, then a content key corresponding to the *unique* apparatus-specific ID is read. The ability to receive the content key is understood by one of ordinary skill in the art to represent a permission to use the content to which the key corresponds. Therefore, the content key can be interpreted as a “license parameter” (see definition of license above). Because the content key corresponds to a unique apparatus-specific ID, then the apparatus-specific ID can also be interpreted as a “license parameter.”

26. Regarding claims 11 and 21, Applicants argue:

Given that Yamauchi identifies the possibility that other devices can use the content key as the concern being addressed by the invention, applicants submit that the content key is not issued to a specific apparatus and, therefore, the apparatus-specific ID of Yamauchi cannot be a parameter of the license. It is a parameter only of the apparatus. (pp. 11-12 of the 08 Remarks)

y. The Examiner respectfully disagrees for the same reasons as above.

27. Regarding claims 11 and 21, Applicants argue:

Second, the process set forth in paragraph 0030 does not in fact meet, as the examiner appears to contend, the limitation of "storing the restored authorization code in the data-processing device connected to the computer of the licensee in a device-specific format in the data-processing device." This process step occurs after the authorization code - the "restored authorization code" -- is returned from the licensor, which occurs after the license parameters are sent.

z. The Examiner respectfully disagrees. Yamauchi's memory card of figure 2 is disclosed as meeting this step. The memory card stores the content key for the audio device of figure 1. Moreover, the order of the method steps in claims 11 and 21 are not required by the claim. The "restored authorization code" is not claimed as being different than the "authorization code."

28. Regarding claims 11 and 21, Applicants argue:

The content reproduction device of Yamauchi is the device to which the content key is to be restored. Thus, it would have to correspond to the "data processing device" in the claims for the process of Yamauchi to meet the limitations in the manner contended by the examiner.

aa. The Examiner respectfully disagrees. First, Applicants are arguing limitations that are not found in the claims. The Examiner cannot find in the claims where the authorization code is restored to the "data processing device." Second, the reproduction

device of Yamauchi (i.e. the audio device of figure 1) receives a restored authorization code in the same manner as the claimed "computer of the licensee." Contrary to Applicants' interpretation, the Examiner interprets Yamauchi's device to be the claimed "computer of the licensee." For further clarification of the rejection above, the Examiner also interprets the memory card of Yamauchi to be the claimed "data processing device" and the server of Murakami to be the claimed "licensor." Third, Applicants appear to be arguing the references separately. In the rejection above, the Examiner relies on the server of Murakami to perform the functions of the memory card of Yamauchi. Murakami discloses a device/server relationship in at least figure 6, in which a device can request information from a server. Accordingly, the Examiner argues that it would have been obvious to use the method in ¶ 0030 of Yamauchi in a similar device/server relationship using the device of Yamauchi and the server of Murakami. In this way the device receives the restored key from the server instead of the memory card. The server of Murakami would perform the same method as the memory card of Yamauchi. Fourth, the memory card of Yamauchi stores the key in a "device specific format," otherwise the device of Yamauchi would not be able to retrieve it from the memory card and use it.

29. Regarding claims 11 and 21, Applicants argue:

If a licensor server is substituted for the memory card in the process of claim 0030, the combination fails to teach an "access protected data processing device" connected to the licensee's computer, as required by claims 11 and 21, to which the restored authorization code is saved once it is returned from the licensor.

bb. The Examiner respectfully disagrees. Yamauchi discloses an "access protected data processing device" in disclosing the memory card that is connected to the audio

device of figure 1 (i.e. “licensee’s computer). The Examiner has never said that the “licensor server is substituted for the memory card in the process of *claim* 0030.” The Examiner simply states “it would have been obvious... to use the licensor server of Murakami in place of the memory card of Yamauchi to backup the license key and to provide recovery of the license key” (see rejection above and argument directly above).

Waiver of Rights

30. Applicants argue, “applicants would like to address the most notable errors, reserving for later the opportunity to address the remaining errors” (Applicants’ 08 Remarks). Applicants’ reservation is hereby denied. Additionally, Applicants state that they “see no need to address the remaining errors, especially as to the dependent claims. By not addressing the remaining errors or any particular interpretation given to the claims or to the prior art, applicants do not intend to waive the right to complain of the errors or to exhibit acquiescence to any particular interpretation” *Id.* The Examiner disagrees since there *is* a need to address the remaining errors since 37 C.F.R. §1.111(b) *requires* Applicants to address the remaining errors.

31. Applicants are reminded that examiners have no authority to waive 37 C.F.R. §1.111(b) (see *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987)). Additionally an applicant is required to point out *any* supposed errors in the office action in his or her next response. In this application, the Examiner is therefore presented with two possible scenarios.

32. First, the Examiner could treat Applicants’ 08 Remarks as a violation of 37 C.F.R. §1.111(b) since Applicants have shown express intent (as noted above) to not respond to the ‘supposed errors’ made in the 12 August 2008 Office Action (“Aug 08 Action”). In light of the

calendar dates involved with the Aug 08 Action and the 08 Remarks, under the first scenario, Applicants' application is abandoned.

33. Second, the Examiner could alternatively treat Applicants' 08 Remarks as complying with 37 C.F.R. §1.111(b). In order to comply with the second scenario, Applicants' 08 Remarks must therefore be considered a waiver of any right to respond to the so called "remaining errors." Under this second scenario, the application is *not* abandoned since compliance with of 37 C.F.R. §1.111(b) is met.

34. In light of the above and to provide compact prosecution while reducing pendency, the Examiner chooses scenario two. Thus, it is the Examiner's position that any arguments Applicants should have made in their 08 Remarks are hereby waived. Applicants are cautioned that should Applicants' present any arguments that could have been made in their 08 Remarks and/or are directed to the so called "remaining errors," the Examiner will have no choice but to treat the 08 Remarks as being in violation of 37 C.F.R. §1.111(b) (*i.e.* Scenario one). As noted above, if the 08 Remarks is in violation of 37 C.F.R. §1.111(b), this application is abandoned (see *In re Goodman*, 3 USPQ2d 1866 (ComrPats 1987)).

Conclusion

35. Applicants' 08 Amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

not a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C.

Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Examiner, Art Unit 3621
February 13, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621